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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,508	08/26/2003	Dennis M. Wiedeman	16356.830 (DC-01970B)	5789
27683	7590	03/14/2005		EXAMINER
HAYNES AND BOONE, LLP 901 MAIN STREET, SUITE 3100 DALLAS, TX 75202			PHAN, TRI H	
			ART UNIT	PAPER NUMBER
			2661	

DATE MAILED: 03/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/649,508	WIEDEMAN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Tri H. Phan	2661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 08 November 2004.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-21 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-21 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 16 November 2004 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>2/6/2004</u> .	6) <input type="checkbox"/> Other: _____ .

## **DETAILED ACTION**

### ***Drawings***

1. The formal drawings were received on November 16<sup>th</sup>, 2004. These drawings are acceptable by the Examiner.

### ***Claim Objections***

2. Claims 1 and 8 are objected to because of the following informalities:

Claim 1, lines 8-10, it recites the limitation “selected first and second SUTs being ...., selected remaining first and second SUTs being ...”; which is a method claim, not a system claim.

Claim 8, line 2, “VLAN’s” is a typographical error; it should be correct to -- VLANs --.

Appropriate corrections are required.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-30 of U.S. Patent No. 6,654,347 (hereinafter ‘347’). Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Claims 1 and 16 of patent ‘347’ teach essentially the same system and method for dynamically implementing the virtual local area networks ‘VLAN’, which comprise the first VLAN-capable switch, the second VLAN-capable switch, the first uniquely identified system under test ‘first SUT’ connected to the first VLAN-capable switch, the second uniquely identified system under test ‘second SUT’ connected to the second VLAN-capable switch as recited in claims 1 and 12 of the current application. Even though, the patent claims ‘347’ provide the “means for connecting … first and second SUTs connected to the virtual private network”; one of ordinary skill in the art will understand that “being dynamic connected the selected first and second SUTs to form the first private VLAN and the remaining first and second SUTs to form the second private VLAN” is the obvious variation of “means for connecting …” of the patent ‘347’ with “first and second private VLANs”.

Claims 9 and 24 of patent ‘347’ teach essentially the same system and method for connecting the first/second SUTs with the first/second customer networks via the first/second virtual private networks ‘VPN’; which are the obvious variation of “custom configuring the first/second SUTs in the first/second private VLANs” as recited in claims 2-3 and 13-14 of the current application. Even though, the patent claims ‘347’ do not explicitly disclose the “customer

server” to provide custom configuration for the SUTs; one of ordinary skill in the art will understand that a customer server is required in the customer network for performing the connecting and disconnecting between the SUTs with the customer network via first/second VPNs, as well as providing the custom configuration to the SUTs as recited in claims 7-9 and 17-19 of the current application.

Claims 1 and 16 of patent ‘347’ teach essentially the same system and method for connecting the first/second SUTs with the first/second VLANs via the first/second burn rack switches as recited in claims 10-11 and 20-21 of the current application and where the “third VLAN-capable switch” as recited in claim 6 of the current application is obvious to the VLAN-capable switches in the multiple VPNs as claimed in claims 8 and 20 of patent ‘347’. Even though, the patent claims ‘347’ do not explicitly disclose about the first/second SUTs “are tested” in the first/second private VLAN; one of ordinary skill in the art will understand that the “burn rack” is used for testing and software configuration, which are the obvious variation of “tested” method as recited in claims 4-5 and 15-16 of the current application.

#### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over **McNeill et al.** (U.S.6,167,052) in view of **Silva et al.** (U.S.6,167,537).

- In regard to claims 1 and 12, **McNeill** discloses about the *method and system for dynamically implementing the virtual LAN “VLAN”* (For example see Figs. 1-2; col. 2, lines 17-56), which comprise the first VLAN-capable switch ('VLAN-capable switches 128.1-128.2' in Fig. 1), the second VLAN-capable switch ('VLAN-capable switches 128.3-128.6' in Fig. 1), a plurality of first uniquely identified systems connected to the first VLAN-capable switch ('stations 124.1-124.2' in Fig. 1; wherein each station is identified by its VLAN identification or MAC address as disclosed in col. 6, lines 14-23), a plurality of second uniquely identified systems connected to the second VLAN-capable switch ('station 124.3' in Fig. 1; wherein other stations are obvious connected to VLAN-capable switches 128.3-128.6), selected first and second uniquely identified systems ('management connectivity group') being dynamically connected to form the first private VLAN, selected remaining first and second uniquely identified systems ('unmanagement connectivity group') being dynamically connected to form the second private VLAN (For example see Figs. 1-2; col. 4, line 43 through col. 5, line 14; Appendix A-E).

**McNeill** does disclose about the process of creating connectivity groups allowed to communicate, e.g. creating VLANs, VLAN identifiers and access control lists ("uniquely identified systems"; For example see col. 4, lines 43-52; col. 6, lines 15-22), but fails to explicitly disclose that the connectivity groups are "system under test SUTs". However, such implementation is known in the art.

For example, **Silva** discloses an automatic testing system for software and hardware test to be performed over the networks as specified in Col. 8, Lines 50-62, which include the *first and second system under test SUTs located at the first and second sites* (test machines 23 in Figs. 1-

2; For example see Col. 8, Lines 9-16; Col. 5, Lines 6-20) *connected to the first and second VLAN-capable switch* (dispatchers 17 in Figs. 1-2; For example see Col. 3, Lines 40-51; Col. 5, Lines 6-20).

Thus it would have been obvious to the person of ordinary skill in the art at the time of the invention was made to implement the automatic testing system as taught by **Silva** in **Brady's** system, with the motivation being to distribute the testing hardware and software system from any location over other network outside of the connectivity group as disclosed in **Silva**: col. 2, lines 20-25.

- Regarding claims 2-5 and 13-16, **McNeill** further discloses about the *selected and remaining systems are custom configured and tested* (For example see col. 4, lines 43-52; wherein the process of creating connectivity groups, e.g. creating VLANs and access control list, is performed by the network administrator as disclosed in col. 6, lines 14-23); but fails to explicitly disclose that the connectivity groups are “*system under test SUTs*”, which “*are tested*” in the first and second VLAN. However, such implementation is known in the art.

For example, **Silva** discloses an automatic testing system for software and hardware test to be performed over the networks as specified in Col. 8, Lines 50-62, which include the *first and second system under test SUTs located at the first and second sites* (test machines 23 in Figs. 1-2; For example see Col. 8, Lines 9-16; Col. 5, Lines 6-20) *connected to the first and second VLAN-capable switch* (dispatchers 17 in Figs. 1-2; For example see Col. 3, Lines 40-51; Col. 5, Lines 6-20) for testing.

Thus it would have been obvious to the person of ordinary skill in the art at the time of the invention was made to implement the automatic testing system as taught by **Silva** in **Brady's** system, with the motivation being to distribute the testing hardware and software system from any location over other network outside of the connectivity group as disclosed in **Silva**: col. 2, lines 20-25.

- In regard to claim 6, **McNeill** further discloses about the “*third VLAN-capable switch*” (‘switch 128.7’ in Fig. 1).

- Regarding claims 7-9 and 17-19, **McNeill** further discloses about the *customer server to provide custom configuration* (‘management station’ in Fig. 1; For example see col. 4, lines 9-11, 39-52; wherein the network administrator defines VLANs, VLAN identifier for each station and creates the connectivity groups, e.g. “*provide custom configuration*”, as disclosed in col. 5, lines 1-21; col. 6, lines 15-33); but fails to explicitly disclose about the “*system under test SUTs*”.

However, such implementation is known in the art.

For example, **Silva** discloses an automatic testing system for software and hardware test to be performed over the networks as specified in Col. 8, Lines 50-62, which include the *first and second system under test SUTs located at the first and second sites* (test machines 23 in Figs. 1-2; For example see Col. 8, Lines 9-16; Col. 5, Lines 6-20) *connected to the first and second VLAN-capable switch* (dispatchers 17 in Figs. 1-2; For example see Col. 3, Lines 40-51; Col. 5, Lines 6-20).

Thus it would have been obvious to the person of ordinary skill in the art at the time of the invention was made to implement the automatic testing system as taught by **Silva** in **Brady's** system, with the motivation being to distribute the testing hardware and software system from any location over other network outside of the connectivity group as disclosed in **Silva**: col. 2, lines 20-25.

- In regard to claims 10-11 and 20-21, the combination of **McNeill** and **Silva** fails to explicitly disclose about the “*burn racks*” for test machines. However, it is obvious that in order to test multiple test machines connected by the multiplexed array connectors for performing the test program as disclosed in **Silva**: col. 8, lines 15-49, it should use a “*rack*” or “*burn racks*” to hold the test machines. Thus it would have been obvious to the person of ordinary skill in the art at the time of the invention was made to implement the “*burn racks*” into the testing system as taught by **Silva** and **Brady**, with the motivation being to distribute the testing hardware and software system from any location over other network outside of the connectivity group and maximize efficiency in the sharing resources as disclosed in **Silva**: col. 8, lines 29-49.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**Gage et al.** (U.S.6,035,405), **Sprenger et al.** (U.S.5,861,882), **Brady et al.** (U.S.5,914,938), **Kok et al.** ("Simple IP Subnet VLAN Implementation", January 2001, Faculty of Information Technology, CyberJaya, Malaysia, IEEE, 1531-2216/01, pages 160-165) and

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**Frohnhoff et al.** ("An Advanced TMN Test System -TSE-P-, Deutsche Telekom AG, Technologiezentrum Darmstadt, April 1996, IEEE, 0-7803-2518-4/96, pages 444-453) are all cited to show devices and methods for improving the testing system for the LAN in the telecommunication architectures, which are considered pertinent to the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tri H. Phan, whose telephone number is (571) 272-3074. The examiner can normally be reached on M-F (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau T. Nguyen can be reached on (571) 272-3126.

**Any response to this action should be mailed to:**

**Commissioner of Patents and Trademarks**

Washington, D.C. 20231

**or faxed to:**

**(703) 872-9314**

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office, whose telephone number is (703) 305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tri H. Phan  
March 3, 2005



**BRIAN NGUYEN  
PRIMARY EXAMINER**